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### REMARKS

Claims 1, 4-8, 10, 13-17 and 19-21 are all the claims presently pending in the application. The specification and claims 1, 4, 6-7, 10, 13, 15-16, and 19-21 are amended to more clearly define the invention. Claims 1, 10, and 21 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Entry of this §1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner. As such, entry of this Amendment is believed proper and Applicant earnestly solicits entry. No new matter has been added.

Claims 1, 4-8, 10, 13-17 and 19-21 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Kanari et al. reference (U.S. Patent No. 6,234,697).

This rejection is respectfully traversed in the following discussion

#### **I. THE CLAIMED INVENTION**

A first exemplary embodiment of the claimed invention, as recited by independent claim 1, is directed to a mechanical pencil that includes a barrel, a lead feeding mechanism disposed in the barrel to tighten and feed a lead, and a single-piece lead holder disposed between the lead feeding mechanism and a tip end of the barrel. The lead holder has a

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through hole through which the lead penetrates, the single-piece lead holder includes holding portions for holding the lead, and a contact portion for contacting an inner peripheral face of the barrel. The holding portions include a first holding portion at a front portion of the lead holder and a second holding portion at a rear portion of the lead holder, so that when a length of the lead becomes shorter than a distance between the lead feeding mechanism and the tip end of the barrel, the first holding portion holds the short lead and the second holding portion holds a next lead tightened by the lead feeding mechanism. The contact portion includes an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel.

A second exemplary embodiment of the claimed invention, as recited by independent claim 10, is directed to a writing instrument that includes a barrel, a writing medium feeding mechanism disposed in the barrel to tighten and feed a writing medium, and a single-piece writing medium holder disposed between the writing medium feeding mechanism and a tip end of the barrel. The writing medium holder has a through hole through which the writing medium penetrates. The single-piece writing medium holder includes holding portions for holding the writing medium, and a contact portion for contacting an inner peripheral face of the barrel. The holding portions include a first holding portion at a front portion of the writing medium holder and a second holding portion at a rear portion of the writing medium holder, so that when a length of the writing medium becomes shorter than a distance between the writing medium and the tip end of the barrel, the first holding portion holds the short writing medium and the second holding portion holds a next writing medium tightened by the writing medium feeding mechanism. The contact portions include an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of

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the barrel.

A third exemplary embodiment of the claimed invention, as recited by independent claim 21, is directed to a writing instrument that includes a tip end of a barrel, and a single-piece writing medium holder held by the tip end of the barrel having a through hole through which a writing medium penetrates. The single-piece writing medium holder includes holding portions for holding the writing medium including a first holding portion at a front portion of the single-piece writing medium holder and a second holding portion at a rear portion of the single-piece writing medium holder. The holding portions being formed at two or more positions along an axial length of the writing medium holder. The holding portions including a first holding portion at a front portion of the single-piece writing medium holder and a second holding portion at a rear portion of the single-piece writing medium holder, and an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel. When a length of the writing medium becomes short, the first holding portion holds the writing medium and the second holding portion holds an unused writing medium.

In this manner, the lead holder always maintains frictional contact with the inner peripheral face of the barrel and therefore, always fixes the lead (or two leads) relative to the barrel.

Further, the single-piece lead holder simplifies construction and reduces cost by reducing the number of parts.

Regarding claims 6-7, 15-16, and 20, the holding portions include a first holding portion at a front portion of the lead holder and a second holding portion at a rear portion of the lead holder. When the preceding lead becomes shorter than a distance between the lead

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feeding mechanism and the tip end of the barrel, the first holding portion of the lead holder holds the short preceding lead and the second holding portion of the lead holder holds a next lead. Therefore, a length of a remainder lead can be decreased significantly.

## II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claim 20 is indefinite. While Applicants submit that such would be clear to one of ordinary skill in the art taking the present Application as a whole, to speed prosecution claim 20 has been amended in accordance with Examiner Prunner's very helpful suggestion.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

## II. THE PRIOR ART REJECTION

Regarding the rejection of claims 1, 4-8, 10, 13-17 and 19-21, the Examiner alleges that the Kanari et al. reference teaches the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by the Kanari et al. reference.

The Kanari et al. reference does not teach or suggest the features of the present invention including a single-piece lead holder with contact portions that include an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel. As explained above, this feature is important for always maintaining frictional contact with the inner peripheral face of the barrel and therefore, always fixing the lead (or two leads) relative to the barrel.

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Rather, the Kanari et al. reference discloses a lead holder that includes a lead holding member 36 and a slider 44. Therefore, the Kanari et al. reference does not teach or suggest a single-piece lead holder.

Further, the lead holder 36 of the Kanari et al. reference does not include contact portions include an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel. Rather, the Kanari et al. reference includes a slider-resisting member 46 that intervenes between the slider 44 and an inner peripheral surface of the mouthpiece 32.

More particularly, the releasing portion 48 of the slider 44 allows the frictional resistance of the slider-resisting member 46 to be reduced or completely overcome. Thus, when the lead is projected from the tip end of the barrel, the holder (36, 44) does not have any (or has very little) frictional contact with the inner peripheral face of the barrel, and can be moved with the lead from the state shown in Fig. 2 to the state shown in Fig. 4.

In other words, the holder (36, 44) does not fix the lead relative to the barrel during writing. Only when the lead is retracted into the barrel as shown in Fig. 5 of Kanari, et al. does the holder (36, 44) come into contact with the inner peripheral face of the barrel via the slider-resisting member 46 to keep the lead inside of the barrel.

In stark contrast, the present invention includes contact portions that include an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel. In this manner, the lead holder always maintains frictional contact with the inner peripheral face of the barrel and therefore, always fixes the lead (or two leads) (writing medium in the case of claim 21) relative to the barrel.

Therefore, the Kanari et al. reference does not teach or suggest each and every

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element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection of claims 1, 4-8, 10, 13-17 and 19-21.

### III. FORMAL MATTERS AND CONCLUSION

The Office Action objects to the drawings. In particular, the Examiner alleges that the drawings do not show the "operating part." However, contrary to the Examiner's allegations none of the claims recite an "operating part." Applicants respectfully request withdrawal of this objection.

The Office Action objects to the specification. In particular, the Examiner alleges that the specification does not provide "proper antecedent basis" for the claimed subject matter. This Amendment amends the specification in accordance with Examiner Prunner's very helpful suggestions.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-20, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

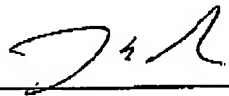
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 10/15/03

  
James E. Howard  
Registration No. 39,715

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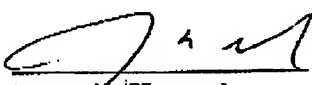
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**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Kathleen J. Prunner, Group Art Unit # 3751 at fax number 703-872-9303 this 15<sup>th</sup> day of October, 2003.

  
James E. Howard  
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